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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IVAN MARKOVIC and IVOR DURHAM

Appeal No. 2004-0325
Application No. 08/978,753

ON BRIEF

MAILED

SEP 10 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before KRASS, BARRETT and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-47.

The invention pertains, generally, to the creation and display of documents. In particular, a method of depicting a hard copy document is disclosed wherein a user selects an instruction for assembling a hard copy document and a visual appearance of a first electronic document, once printed and

Appeal No. 2004-0325
Application No. 08/978,753

assembled in accordance with that instruction, is determined in the computer and the determined visual appearance is produced as an output. Thus, the computer creates and displays electronic documents that accurately depict hard copy documents.

Representative independent claim 1 is reproduced as follows:

1. A method of depicting a hard copy document, comprising:
 - receiving in a computer a first electronic document having a content;
 - receiving in the computer a user input that selects an instruction for assembling a hard copy document;
 - determining in the computer indicia of assembly and a visual appearance of the first electronic document as if printed and assembled in accordance with the instruction; and
 - displaying the determined visual appearance with the indicia of assembly overlaid with the content.

The examiner relies on the following references:

Miller et al. (Miller)	5,696,605	Dec. 9, 1997
		(filed Nov. 20, 1992)
Takakura et al. (Takakura)	5,752,053	May 12, 1998
		(filed May 18, 1995)
Tabata et al. (Tabata)	5,774,232	Jun. 30, 1998
		(filed Sep. 21, 1995)

Claims 1-47 stand rejected under 35 U.S.C. § 103 as unpatentable over Tabata in view of Miller and Takakura.

Appeal No. 2004-0325
Application No. 08/978,753

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We REVERSE.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Appeal No. 2004-0325
Application No. 08/978,753

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

At the outset, we note, with curiosity, the examiner's explanation of the rejection of independent claim 1, for example. At pages 3-4 of the answer, in explaining the relevance of the primary reference to Tabata, the examiner explains that "Tabata...fail to teach: receiving in a computer a first electronic document;" "Tabata...fail to teach: receiving in the computer a user input that selects an instruction for assembling

Appeal No. 2004-0325
Application No. 08/978,753

a hard copy document;" "Tabata...fail to explicitly disclose: determining in the computer indicia of assembly and a visual appearance of a first electronic document as if printed and assembled in accordance with the instruction and displaying the determined visual appearance."

That is, the examiner appears to be admitting that Tabata, the primary reference upon which the rejection of all the claims is based, discloses *not* one of the claimed steps. If this is what the examiner believes, one is left to wonder why the reference was used at all in the rejection.

In any event, we have reviewed the references, as well as the arguments of both appellants and the examiner, and we find that the examiner has not established a *prima facie* case of obviousness with regard to the instant claimed subject matter.

As we read Tabata, the reference certainly teaches the receipt in a computer of an electronic document. The reference also teaches the receipt in the computer of a user input that selects an instruction for assembling a hard copy document. This is shown, for example, in Figure 20A, wherein a user selects a staple position. The staple position may be an instruction for assembling a hard copy document. One might even argue that Tabata determines in the computer an indicia of assembly, by

determining the staple position. However, we find nothing in Tabata regarding the claimed features of determining in the computer a "visual appearance of the first electronic document as if printed and assembled in accordance with the instruction" and then "displaying the determined visual appearance with the indicia of assembly overlaid with the content."

Tabata may show a visual appearance of how a staple, placed in various positions, will appear on a document (see Figure 20A), but it clearly does not disclose any visual appearance of the document "as if printed and assembled" in accordance with the user's instruction. That is, the "document" shown in Tabata's Figure 20A is not the electronic document "as if printed and assembled..." Additionally, there is no indication in Tabata that the actual content of the document is displayed with a visual appearance so that the determined visual appearance with the indicia of assembly overlaid with the content is displayed.

The examiner appears to rely on Miller for storing information but Miller does not appear to display anything but scanned image data from a hard copy document, offering nothing in the way of the display of indicia of assembly of a document overlaid with the content of that document. Accordingly, Miller

Appeal No. 2004-0325
Application No. 08/978,753

does not provide for the deficiency, noted supra, with regard to Tabata.

With regard to Takakura, this reference discloses a document processing system wherein various characters are input and edited to arbitrary positions on a document while observing the state of the print bound document. The reference also describes an integrated document having a plurality of pages which can be output by a single output instruction.

The examiner employs Takakura for a teaching of displaying a visual representation ("forms" and "print binding") of a document as if printed (see answer-page 5) and contends that it would have been obvious to combine Takakura with Tabata because Takakura teaches "a format can be changed on a page unit...by a single output instruction" (answer-page 5).

We cannot say that we fully understand the examiner's rationale for combining Takakura with Tabata, but it does appear to us, as it does to appellants, that the "single output instruction" of Takakura is merely a print button for printing out the document, the instruction having nothing to do with assembly instructions. Further, we find nothing in Takakura, and the examiner has not convincingly pointed to anything in Takakura, suggesting a display of a determined visual appearance

Appeal No. 2004-0325
Application No. 08/978,753

with the indicia of assembly overlaid with the content, as claimed.

Accordingly, since the combination of the Tabata, Miller and Takakura references as applied by the examiner, is not seen to obviate the subject matter of independent claim 1, we will not sustain the rejection of this claim, or of dependent claims 2-22, 28-37, and 41-45, under 35 U.S.C. § 103.

Since the remaining independent claims 23, 24, 27, 38-40, 46 and 47 all contain limitations similar to those in claim 1, regarding determining a visual appearance of the document, having content, as printed, arranged in accordance with assembly or formatting instructions, we also will not sustain the rejection of claims 23-27, 38-40, 46 and 47 under 35 U.S.C. § 103.

Appeal No. 2004-0325
Application No. 08/978,753

The examiner's decision rejecting claims 1-47 under
35 U.S.C. § 103 is reversed.

REVERSED



ERROL A. KRASS

Administrative Patent Judge

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LEE E. BARRETT

Administrative Patent Judge

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MAHSHID D. SAADAT

Administrative Patent Judge

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Appeal No. 2004-0325
Application No. 08/978,753

FISH & RICHARDSON P.C.
500 ARGUELLO STREET
SUITE 500
REDWOOD CITY, CA 94063